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IN THE

Supreme Court of the United States

October Term, 1958.

No. [redacted] 142

CHAS. PFIZER & CO., INC.,
Petitioner,

v.

G. D. SEARLE & CO.,
Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

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June 25, 1959.

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

To the Honorable Earl Warren, Chief Justice, and the Associate Justices of the Supreme Court of the United States:

Your petitioner, Chas. Pfizer & Co., Inc., respectfully prays that a writ of certiorari issue to review a final judgment of the United States Court of Appeals for the Seventh Circuit reversing a judgment for petitioner entered by the United States District Court for the Northern District of Illinois, in an action for trademark infringement and unfair competition entitled *G. D. Searle & Co. v. Chas. Pfizer & Co., Inc.*, Civil Action No. 53 C 2407. The aforesaid judgment by the court of appeals set aside the findings of fact by the district court, made contrary findings of fact, and directed the district court to issue an injunction restraining petitioner from using its trademark BONAMINE on a motion sickness remedy.

The trial court had previously found, on substantial credible evidence adduced during the trial, that petitioner's trademark BONAMINE and respondent's trademark DRAMAMINE are "unlike", thereby disposing of the ultimate factual issue involved in the case, i.e.—whether petitioner's mark was likely to be confused with respondent's mark. This finding alone was dispositive of the case, but the trial court also made subsidiary findings from the evidence adduced in open court, that (a) the common "amine" suffix of both trademarks accurately described the chemical and physiological nature of each product, (b) numerous pharmaceutical products had been sold for years under trademarks with an "amine" suffix, (c) the trademarks do not sound alike, (d) the products differ from each other in color, in size, and in packaging, and (e) the products are purchased with great care. (J. A. 1278-1279; App. B, *infra*, 10a-11a.)

The appellate court ignored the substantial evidence on which these findings were bottomed, arbitrarily categorized the ultimate finding as "clearly erroneous", and treated the remaining findings as inadequate or nonexistent. Moreover, although the appellate court had no opportunity to see or to appraise the credibility of the witnesses, it then proceeded to resolve conflicting testimony and make its own findings of fact—instead of remanding the action to the trial court for supplemental findings. In doing so, it ignored the undisputed facts of record, that the only common portion of the two trademarks—the "amine" suffix—was in the public domain as a generic or descriptive name of the class of chemicals to which both products belong; and that this suffix has long been widely used in trademarks for medicinal products, including antihistamines and motion sickness remedies.

OPINIONS BELOW.

The district court's opinion in prior proceedings on petitioner's motion for summary judgment (App. B, *infra*, 2a) is reported in 130 F. Supp. 811. The opinion of the court of appeals remanding the cause for trial (App. B, *infra*, 4a) is reported in 231 F. 2d 316. After the trial, the district court filed no opinion as such, but filed findings of fact and conclusions of law (J. A.[1] 1277; App. B, *infra*, 9a) which are reported in 159 F. Supp. 878. The opinion of the court of appeals on the second appeal (App. B, *infra*, 12a) is reported in 265 F. 2d 385.

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1. The record filed with this petition comprises certified copies of the documents listed below. References to pages of each document will be prefixed by the identifying letters shown:

Identifying Prefix	*Name of Document*	*Date Filed in Court of Appeals*
J.A.	Joint Appendix (2 volumes)	August 11, 1958
D.A.	Defendant-Appellee's Appendix [Bound with Brief of Appellee]	September 29, 1958
P.A.	Plaintiff-Appellant's Appendix [Bound with Reply Brief of Appellant]	October 14, 1958
Op.	Opinion of Court of Appeals [Certified with Joint Appendix]	March 26, 1959
(None)	Order of Court of Appeals on Opinion [Certified with Joint Appendix]	March 26, 1959
(None)	Order of Court of Appeals denying rehearing [Certified with Joint Appendix]	April 28, 1959

QUESTIONS PRESENTED.

1. Where the evidence indisputably establishes that two trademarks for motion sickness remedies contain a common suffix which is in the public domain and which accurately describes each product, coupled with dissimilar prefixes, may a finding of fact by the trial court that the trademarks are "unlike" be set aside by the appellate court as being "clearly erroneous"?

2. Where a trademark owner concedes that its charge of infringement is based upon supposed similarity of sounds, may a specific finding of fact by the trial judge that the trademarks are not acoustically similar, which is supported by substantial credible evidence, including testimony of expert and other witnesses and observations by the trial judge as to the manner of pronunciation of the words by counsel and witnesses throughout the proceedings, be ignored on the novel theory that the trial judge applied "a side by side comparison" of sounds which is "not a correct test" for acoustic similarity?

3. Where findings of fact made by a trial judge who has heard witnesses testify in person during a long trial are held to be insufficient, should the cause be remanded to the trial court for supplemental findings of fact or may the appellate court resolve sharp conflicts in the evidence and make its own findings from the paper record?

JURISDICTION.

The judgment of the court of appeals was entered on March 26, 1959. Timely petition for rehearing was filed by petitioner on April 10, 1959, which was denied on April 2, 1959. The jurisdiction of this Court is invoked under 28 U. S. C. § 1254(1).

STATUTES INVOLVED.

The statutory provisions involved are Sections 32(1) and 45 of the Trademark Act of 1946, 15 U. S. C. §§ 1114(1) and 1127; and Rule 52(a) F. R. C. P. They are printed in Appendix A (*infra*, 1a).

STATEMENT.

In the district court petitioner was charged with infringement of respondent's registered trademark DRAMAMINE arising from petitioner's use of its trademark BONAMINE for a motion sickness remedy sold in competition with that of respondent. The unfair competition charge was based on the same act. The action was first considered by the district court on petitioner's motion for summary judgment based on respondent's answers to interrogatories and on affidavits and exhibits establishing the essential indisputable facts with regard to the products in issue and the manner in which they were advertised and sold.

After consideration of these evidentiary facts and additional undisputed evidentiary facts submitted by respondent, the district court granted petitioner's motion holding (App. B, *infra*, 2a-3a):

> "On the basis of the whole record; having in mind not only a comparison of the appearance, packaging, price and trade names of the two products involved herein, as shown in the exhibits, but also the nature of the products themselves, and the manner and conditions under which these two products are sold; and bearing in mind the effect which would be produced in the mind of the ordinary purchaser, exercising due care and caution, when confronted by the products singly presented; the Court is of the opinion that there is little likelihood that such a purchaser would be misled or deceived into accepting the product of the defendant for that of the plaintiff."

On respondent's appeal, the Court of Appeals for the Seventh Circuit reversed on the ground that the ultimate question of likelihood of confusion constituted *a disputed question of fact* that should not be determined in a summary judgment proceeding (App. B, *infra*, 7a). The action was remanded for a trial of this *fact* question (App. B, *infra*, 8a).

At the subsequent trial in the district court, the evidence was undisputed that both petitioner's and respondent's products are members of the large class of chemical compounds known as organic *amines* (i.e., derivatives of ammonia), and both are physiologically known as antihistamines (J. A. 66-67, 126-27, 216, 350-51, 430, 478, 480, 706, 847, D. A. 2a). There are thousands of organic amines (J. A. 478-79, 848-49, 899-900, Def. Exs. 52, 53). Indeed, the word "amine" is so common that it is defined in standard desk dictionaries, as well as in technical publications (J. A. 721, Def. Exs. 51B, 52, 53). Thus the amine suffix in petitioner's and respondent's trademarks is a well known technical term which accurately describes both the chemical and physiological nature of these products.

The evidence showed beyond question that for many years there had been a general custom in the pharmaceutical industry to use trademarks containing the descriptive "amine" suffix (J. A. 666-69, 722-27, 729, 855, 895-99, 1243-53). Among many others, such trademarks include APOLAMINE and TRIPAMINE—which are motion sickness remedies directly competitive with DRAMAMINE and BONAMINE (J. A. 56-57, 354, 729-30, 1243)—and SCOPOLAMINE, one of the earliest effective motion sickness remedies, which preceded DRAMAMINE and is still in use (J. A. 64, 773). Respondent's president admitted that "The name 'DRAMAMINE' was coined, as are all our tradenames, from the chemical formulation of the drug" (J. A. 900).

The evidence also showed that to avoid any possibility of confusion of its trademark with those used by competitors, petitioner coupled the "amine" suffix, which was

descriptive of its product, with a distinctive prefix "bon" which is a well-known French word meaning "good" (J. A. 223, 231). The significance of the prefix "bon" is completely different from that of the prefix "dram" of respondent's mark, which connotes a small unit of measure (J. A. 74, 170-71). It is to be noted that "bon" and "dram" do not have a single letter in common, or even the same number of letters.

On the foregoing evidence the district court held that the products in issue "are both members of the large and well-known chemical class of organic amines"; and that "numerous products which have been sold in drug stores for years contain the amine suffix", some of which are antihistamines and some are motion sickness remedies. It also held that "the words BONAMINE and DRAMAMINE are unlike" (J. A. 1278, App. B, *infra*, 10a, Findings Nos. 9-10).

Not only are the respective trademarks of the parties different, but the appearances of the products in issue and of the packages in which they are sold also are different. Petitioner's BONAMINE product is sold in the form of small, white, 25-milligram tablets, whereas respondent's DRAMAMINE product is sold in the form of large, yellow, 50-milligram tablets (Def. Ex. 1, 4A, B. 39). Petitioner's package features the blue and white color combination, with the distinctive name Pfizer prominently displayed across its face, which is standard for a large number of petitioner's products (Def. Ex. 3, 4A, 39, 41; J. A. 440-43). In contrast, respondent's package features its characteristic chocolate brown and robin's egg blue color combination, with the distinctive name Searle prominently displayed (Def. Ex. 1, 2, 4B; J. A. 49-51).

The district court found that "although neither of the tablets is particularly distinctive in appearance, they do differ from each other in color and in size. The packaging also differs" (J. A. 1279, App. B, *infra*, 11a, Finding No. 14).

The court of appeals brushed aside these facts, on the amazing ground that these differences between the products

"would not be helpful" in distinguishing them (Op. 5, App. B, *infra*, 17a). It then went on to hold that confusion is caused by the similarity between the sound of DRAMAMINE and the sound of BONAMINE, because these products are widely promoted and often purchased by word-of-mouth. Respondent had conceded in the district court that its case hinged upon the proposition that DRAMAMINE and BONAMINE sounded alike. Thus this question of acoustic similarity was the controlling fact issue throughout the trial, and it was recognized as the controlling issue by the court of appeals.

The evidence on this issue was in sharp conflict. Both parties produced expert witnesses whose testimony was directed to this specific question. Many other witnesses from various parts of the country pronounced these names on frequent occasions throughout their testimony.

Petitioner's speech expert was Dr. Hilda Fisher, a member of the faculty of Northwestern University, who explained to the trial court the numerous errors in the testimony of respondent's expert and then went on, by reference to (a) accepted rules of phonetics, (b) the speech habits of people from widely separated parts of the United States, and (c) standard dictionaries, to testify that the words BONAMINE and DRAMAMINE are most unlike one another and that in no part of the country would they be pronounced alike, regardless of the background of the person pronouncing them (J. A. 493-95). As clearly explained by Dr. Fisher in her testimony:

> Both DRAMAMINE and BONAMINE have the same suffix "amine", but there is a large body of words in our language which use this suffix.
>
> The first element of a word "normally is most vivid in the memory of a person who hears it or sees it".
>
> "There is no correspondence between the two stressed syllables, the first syllable of BONAMINE and the first syllable of DRAMAMINE."

The first element of each syllable "is a stop consonant, in the case of BONAMINE a 'B' and in the case of DRAMAMINE a 'D'. These are quite distinct. We use them to differentiate meanings in all sorts of words and in all positions of words. Such words as day and bay are quite clearly distinct. The words like rubber and rudder are quite clearly distinct, or, such a word as bid and bib."

"They look differently since the lips are used to make 'b' and the tongue is used to make 'd'. They sound differently.

"Next, there is an 'r' in the word DRAMAMINE. This is an 'r' which is inevitably pronounced. No matter what dialect a person were to live in he would pronounce this 'r', so it is an added phonemic element in this word which would distinguish it from BONAMINE.[2]

"Thirdly, there are the consonants which close the syllables. In BONAMINE there is an 'n' and in DRAMAMINE there is an 'm' and these again distinguish meaning in all sorts of words in all positions.

"The two vowels are different. In the speech of most American speakers the great majority would pronounce the 'o' of BONAMINE as an 'ah', as in 'father' and the 'a' of DRAMAMINE as an 'aa' as in 'hat'. This is the predominant pronunciation of these two vowels.

"Therefore, we have four distinct differences in the pronounciation of the two words."

After pointing out the many critical distinctions between the words BONAMINE and DRAMAMINE, Dr. Fisher concluded (J. A. 495) that they

"are significantly dissimilar"

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2. Although respondent's expert attempted to minimize the importance of this feature in his direct testimony, on cross-examination he admitted that the letter "r" before a vowel is always pronounced and that this letter in DRAMAMINE "does in fact help to distinguish it from BONAMINE" (J. A. 168).

At the conclusion of the trial the district court made the following findings (J. A. 1278, App. B, *infra*, 10a):

> "10. The words Bonamine and Dramamine are unlike. As [respondent] argued that the two words represented sounds which were acoustically similar and often confused, the Court devoted close attention to the two words as variously pronounced by counsel and witnesses throughout the proceedings. It is the finding of the Court that [respondent's] view is not supported by the evidence."

These findings squarely met the issues as to whether the marks were like one another, and whether their pronunciation was so similar as to be likely to cause confusion. The court of appeals discarded the first finding—that the marks were "unlike"—on the ground it was "clearly erroneous"; and it discarded the second finding—that the marks were not acoustically similar—on the ground it was based upon "a side by side comparison" which "is not a correct test" for such an issue (Op. 5, App. B, *infra*, 16a). In doing so it ignored the evidence which fully supported these findings; it ignored Rule 52(a) of the Federal Rules of Civil Procedure; and it established the amazing proposition that a trial judge under our system of jurisprudence cannot adjudicate issues of trademark infringement based on supposed acoustic similarity because listening to the pronunciation of the trademarks during the trial constitutes "a side by side comparison" of sounds, which is "not a correct test" for acoustic similarity.

Ironically enough, in holding that the marks sounded alike the appellate court was relying upon the very record which was before the district court, without benefit of hearing the marks as pronounced by the witnesses during the trial. Thus the "correct test" for acoustic similarity established by the court of appeals evidently excludes the use of the auditory sense.

REASONS FOR GRANTING THE WRIT.

1. The decision of the court of appeals is in direct conflict with (a) prior decisions of this Court, (b) prior decisions of its own, and (c) decisions of courts of other circuits. Indeed, the conflict is such that the action of the court of appeals in holding to be "clearly erroneous" findings of fact supported by substantial credible evidence adduced from witnesses who testified at the trial amounts to such a departure from the accepted and usual course of judicial proceedings as to call for an exercise of this Court's power of supervision.

Rule 52(a) F. R. C. P. (App. A, *infra*, 1a) provides that findings of fact made by the trial judge cannot be set aside unless they are "clearly erroneous", and due regard must be given to the opportunity of the trial court "to judge of the credibility of the witnesses". The controlling decisions leave no doubt that this language expressly forbids an appellate court from setting aside findings of fact which, as here, are supported by substantial evidence adduced during the trial.

In *Graver v. Linde*, 336 U. S. 271, 69 S. Ct. 535 (1949), this Court reversed the judgment of the same court of appeals because it mistakenly set aside findings of fact of the trial judge on the ground that they were erroneous. From the *Graver v. Linde* decision it is crystal clear that an appellate court must make allowance for the advantages possessed by the trial court in appraising the significance of conflicting testimony. And it cannot reverse on the ground that findings are "clearly erroneous" if they are supported by substantial evidence, 336 U. S. 274-275. These basic principles have formed the framework within which Rule 52(a) has subsequently been applied by the various appellate courts.

Following the *Graver v. Linde* case, the court below showed its awareness of the significance of Rule 52(a) in *Benrose Fabrics Corp. v. Rosenstein*, 183 F. 2d 355 (C. A.

7, 1950). It there made the following application of the *Graver v. Linde* doctrine, which has been frequently quoted and consistently applied by other courts (183 F. 2d at 358):

> "From the foregoing facts and certain others, some controverted and some undisputed, with which it is unnecessary to belabor this opinion, it seems clear to us that the evidence was of such character and weight as to support the findings and conclusions. We can conceive of no right upon our part to set them aside, for we cannot say, as a matter of law, that they are clearly erroneous. True, with other courts, we have announced that if findings rest upon documents, depositions or upon mere comparison of names, if credibility of witnesses is not involved, or if the trial tribunal has no opportunity to observe the witnesses, a court of review is as well qualified to pass upon the weight of evidence as is the trial court, but where, as here, conflicting stories are told by witnesses whose credibility is at stake, we may not supersede the determination of the finder of facts and substitute our judgment for his. It is not a question of whether we would have made the same finding; it is rather a question of whether the evidence substantially and adequately supports it."

A very recent trademark decision in another circuit is also in conflict with the decision of the court of appeals in the instant case. In *S. C. Johnson & Son, Inc. v. Johnson*, 121 USPQ 63 (C. A. 6, March 30, 1959), the court of appeals stated (page 73):

> "Where a district court's findings and conclusions that a defendant had no guilty knowledge or fraudulent intent to deceive or pass off its products as those of the plaintiff, that there would be no confusion, mistake, or likelihood thereof as to the source of origin of the parties' respective products, and that defendant's labels

or marks did not infringe plaintiff's trademark, were not clearly erroneous, but were supported by substantial credible evidence, an affirmance of a judgment for the defendant thereon is required."

We respectfully submit that the established principles set forth in the aforementioned cases were violated by the court of appeals when it disposed of the instant case by setting aside the express findings of the trial court (a) that the trademarks involved are "unlike" and (b) that they are "not acoustically similar".

2. The decision of the court of appeals also is in direct conflict with the decision in *Rohr Aircraft Corporation, et al. v. Rubber Teck Inc., et al.*, 121 USPQ 241 (C. A. 9, April 21, 1959). In that case the defendant's name DUO-SEAL was held not to infringe any of several registered trademarks including BOLT O SEAL. The court observed (page 247) that there were some 27 other trademarks registered in the Patent Office by different companies which contained the word "seal" as a suffix, and held that this word was "a descriptive term describing both the device of the plaintiff's and of the defendants", so it was not subject to exclusive appropriation in a trademark.

The decision below also is in direct conflict with decisions in other circuits to the same effect as the above-cited *Rohr Aircraft* case, including:

Pro-Phy-Lac-Tic Brush Co. v. Jordan Marsh Co., 165 F. 2d 549 (C. A. 1, 1948) involving JEWELITE and GEMLITE for toilet sets;

The Upjohn Company v. David Schwartz, 246 F. 2d 254 (C. A. 2, 1957) involving SYRACOL and CHERACOL for cough medicines; and

Pennzoil Co., et al. v. Crown Central Petroleum Corporation, 140 F. 2d 387 (C. A. 4, 1944) involving PENNZOIL and GREENZOIL for motor oils.

3. The court of appeals also so far departed from the accepted and usual course of judicial proceedings as to call for an exercise of this Court's power of supervision in a further respect.

The opinion of the court of appeals (Op. 3-4, App. B, *infra*, 15a) referred to Finding No. 10 of the district court (J. A. 1278, App. B, *infra*, 10a) and erroneously stated that there was "no other finding as to likelihood of confusion".[3] The court implied that, erroneous or not, this was an insufficient finding of fact, and it thereupon proceeded to resolve conflicting evidence and make its own contrary findings.

Under the applicable authorities, even if one assumes that the findings below were inadequate, the most that the court of appeals should have done was to send the case back for supplemental findings or a new trial. It should not have attempted to resolve disputed testimony, make independent findings of its own, and enter a judgment in respondent's favor. 3 Am. Jur. *Appeal and Error* § 1155, page 666.

The proper practice is illustrated by the same court of appeals in *Kweskin v. Finkelstein*, 223 F. 2d 677 (C. A. 7, 1955), wherein it remanded the case for further findings because the findings of the trial court were deemed inadequate. See also *Maher, et al. v. Hendrickson, et al.*, 188 F. 2d 700, 702 (C. A. 7, 1951).

This is not the unusual situation where the record shows there is no conflict in the evidence bearing on the material facts, and an appellate court is in just as good a position to find these facts as the trial court. Such a situation is illustrated by *National Biscuit Co. v. Kellogg Co.*, 91 F. 2d 150, 155 (C. A. 3, 1937) reversed on other grounds 305 U. S. 109 (1938).

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3. The record is to the contrary, and shows that the trial judge made additional findings of fact which directly bear on the question of likelihood of confusion. See Findings Nos. 9, 10, 14, and 15 (J. A. 1278-79, App. B, *infra* 10a-11a).

It is manifest from the record herein, and the disputed testimony referred to heretofore, that in the instant case the conflict in the evidence was so fundamental that the only course open to the court of appeals, if it regarded the findings made by the district court as inadequate, was to remand the case for supplemental findings or a new trial.

4. The questions presented are of great public importance because they involve the construction of the Trade-Mark Act of 1946 as applied to the issue of trademark infringement. This fundamental issue has never been considered by this Court, and the lower courts are in a state of uncertainty as to how questions of "likelihood of confusion" are to be resolved.

This uncertainty is manifest from the lists of cases cited by the court of appeals (Op. 6, App. B, *infra*, 17a-18a) wherein cases with similar suffixes but dissimilar prefixes were held (a) to be confusingly similar and (b) to be *not* confusingly similar. Following these lists the court of appeals commented:

> "In this type of litigation reference to decisions of courts as to other trademarks is not of great help."

Section 32(1) of the Trade-Mark Act of 1946 [15 U. S. Code § 1114(1)] (App. A, *infra*, 1a) gives a right of action based on the use, in commerce, of "any reproduction, counterfeit, copy, or colorable imitation of any registered mark" when such use is "likely to cause confusion or mistake or to deceive purchasers" as to the source of origin of the goods to which it is applied. Section 45 of the Act [15 U. S. Code § 1127] (App. A, *infra*, 1a) defines the term "colorable imitation" as including "any mark which so resembles a registered mark as to be likely to cause confusion or mistake or to deceive purchasers".

In the instant case, as we have shown, the key issue was whether, as respondent contends, the two trademarks are acoustically similar. The trial court, after hearing the

expert witnesses' testimony and listening to the pronunciations used by all witnesses and counsel throughout the proceedings, held they were not. The court of appeals held this amounted to a "side-by-side comparison" which, it said, is "not a correct test" (Op. 6, App. B, *infra*, 16a).

The Act nowhere establishes any test or furnishes any criteria for ascertaining when a mark is "likely to cause confusion or mistake". Accordingly, the uncertainty among the lower courts can be relieved only by this Court.

CONCLUSION.

For the foregoing reasons, this petition for certiorari should be granted.

Respectfully submitted,

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June 25, 1959.

APPENDIX A.

Excerpts From Patent Act of 1946 [Title 15, U.S. Code]

§ 2 [§ 1114] Remedies; infringement; innocent infringement by printers and publishers

(1) Any person who shall, in commerce, (a) use, without the consent of the registrant, any reproduction, counterfeit, copy, or colorable imitation of any registered mark in connection with the sale, offering for sale, or advertising of any goods or services on or in connection with which such use is likely to cause confusion or mistake or to deceive purchasers as to the source of origin of such goods or services; * * * shall be liable to a civil action by the registrant for any or all of the remedies hereinafter provided in this chapter. * * *

§ 45 [§ 1127] Construction and definitions; intent of chapter

In the construction of this chapter, unless the contrary is plainly apparent from the context—

* * *

The term "colorable imitation" includes any mark which so resembles a registered mark as to be likely to cause confusion or mistake or to deceive purchasers.

* * *

Excerpt From Rule 52, F.R.C.P.

"FINDINGS BY THE COURT

"(a) Effect. In all actions tried upon the facts without a jury * * *, the court shall find the facts specially and state separately its conclusions of law thereon and direct the entry of an appropriate judgment; * * *. Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses. * * *"

APPENDIX B.

IN THE UNITED STATES DISTRICT COURT
N. D. ILLINOIS, E. D.

No. 53 C 2407.

G. D. Searle & Co., a Corporation,
Plaintiff,

v.

Chas. Pfizer & Co., Inc., a Corporation,
Defendant.

March 7, 1955.

Opinion.

KNOCH, *District Judge.*

This matter came on to be heard on the defendant's motion for summary judgment in its favor.

The Court has carefully considered the entire record, including the motion itself and the affidavits and exhibits submitted in support of and in opposition to the motion, as well as additional evidence bearing on the manner and conditions of sale. The Court has had the benefit of extensive argument of counsel presented orally and in briefs and memoranda, has studied the authorities to which reference has been made, and is fully advised in the premises.

On the basis of the whole record; having in mind not only a comparison of the appearance, packaging, price and trade names of the two products involved herein,[1] as shown

1. Dramamine and Bonamine.

in the exhibits, but also the nature of the products themselves, and the manner and conditions under which these two products are sold; and bearing in mind the effect which would be produced in the mind of the ordinary purchaser, exercising due care and caution, when confronted by the products singly presented; the Court is of the opinion that there is little likelihood that such a purchaser would be misled or deceived into accepting the product of the defendant for that of the plaintiff.

As plaintiff's allegation of unfair competition is dependent on the charge of colorable imitation of plaintiff's trademark, it requires no further consideration.

The defendant's motion for summary judgment in its favor will, therefore, be granted. An order in conformity with the foregoing may be presented within 5 days.

Appendix B

IN THE UNITED STATES COURT OF APPEALS
SEVENTH CIRCUIT.

No. 11460.

G. D. Searle & Co.,
Plaintiff-Appellant,

v.

Chas. Pfizer & Co., Inc.,
Defendant-Appellee.

March 20, 1956.

Opinion.

DUFFY, *Chief Judge.*

This is an appeal from a summary judgment in favor of the defendant in an action for trade-mark infringement and unfair competition. The trademarks involved are Dramamine used by plaintiff, and Bonamine used by defendant. Both are used as preventives or remedies for motion sickness.

Plaintiff adopted the trademark "Dramamine" in 1948. It expended more than $2,000,000 in advertising and promoting "Dramamine" as a motion sickness preventive and remedy. At the time of the filing of this suit, sales of this item had exceeded $10,000,000. Plaintiff registered its trademark "Dramamine" in the United States Patent Office in 1950.

Defendant adopted and began the use of the trademark "Bonamine" in August, 1953. It claims to have expended $700,000 in sales promotion, and that total sales of "Bonamine" had exceeded $900,000 by September 8, 1954. This action was filed December 16, 1953.

The summary judgment herein was proper only if the pleadings, depositions and admissions on file, together with the affidavits, showed there was no genuine issue as to any material fact. Rule 56, Federal Rules of Civil Procedure, 28 U.S.C.A. Albert Dickinson Co. v. Mellos Peanut Co., 7 Cir., 179 F.2d 265.

To sustain an action for trademark infringement and unfair competition "* * * it is not necessary to show actual cases of confusion since the test under the statute, 15 U.S.C.A. § 1114(1), is likelihood of such confusion." Independent Nail & Packing Co., Inc., v. Stronghold Screw Products, Inc., 7 Cir., 205 F.2d 921, 925; Keller Products, Inc., v. Rubber Linings Corp., 7 Cir., 213 F.2d 382, 386.

Plaintiff filed affidavits of thirteen physicians, twelve pharmacists, four airline hostesses and three members of the public, dealing with the question of likelihood of confusion between Dramamine and Bonamine. On this point, defendant filed two affidavits each by Thomas G. Bradley, its Director of Sales and Promotion.

The first Bradley affidavit, dated May 13, 1954, detailed the steps taken by the defendant in introducing Bonamine to the trade and explained its chemical ingredients. On the question of likelihood of confusion the affidavit stated:

> "Although any and all instances of confusion between Bonamine and any other pharmaceutical product coming to the attention of Pfizer's salesmen throughout the country should be reported to me, I have not received a single report of this nature to date. This confirms my conviction that there is no reasonable likelihood of confusion, mistake or deception between the products Dramamine and Bonamine."

In the second affidavit, filed September 28, 1954, affiant makes this further statement:

> "* * * Pfizer salesmen throughout the country have been under instructions to report any instances of confusion between the products Bonamine and Dramamine. Despite the increased sales of Bonamine, I have not received a single report of this nature to date."

Rule 56(e), Federal Rules of Civil Procedure, 28 U.S.C.A. provides that affidavits may be filed in support of and in opposition to a motion for summary judgment, and in mandatory terms prescribes as follows:

> "(e) Supporting and opposing affidavits shall be made on personal knowledge, shall set forth such facts as would be admissible in evidence, and shall show affirmatively that the affiant is competent to testify to the matters stated therein. * * *".

The statements above quoted made in the affidavits of the defendant's Director of Sales and Promotion constitute defendant's showing as to likelihood of confusion between the products Bonamine and Dramamine. Such showing constitutes merely expressions of affiant's opinion and his legal conclusion.

Under Rule 56(e), such expressions are totally ineffectual, and are not to be given any consideration or weight whatsoever. Sartor v. Arkansas Natural Gas Corp., 321 U.S. 620, 627-628, 64 S.Ct. 724, 88 L.Ed. 967; Jameson v. Jameson, 85 U.S.App.D.C. 176, 176 F.2d 58, 60; United States v. Britten, 3 Cir., 161 F. 2d 921, 928; Subin v. Goldsmith, 2 Cir., 224 F.2d 753, 756-758; Williams v. Kolb, 79 U.S.App.D.C. 253, 145 F.2d 344; State of Washington v. Maricopa County, 9 Cir., 143 F.2d 871, 872; Walling v. Fairmount Creamery Co., 8 Cir., 139 F.2d 318, 323; F.A.R. Liquidating Corp. v. Brownell, 3 Cir., 209 F.2d 375, 379-380. Affidavits which are inadequate under Rule 56(e) must be disregarded. Automatic Radio Manufacturing Co., Inc.,

v. Hazeltine Research, Inc., 339 U.S. 827, 831, 70 S.Ct. 894, 94 L.Ed. 1312.

Since the portions of the Bradley affidavits dealing with likelihood of confusion between Dramamine and Bonamine must be disregarded, we examine the balance of the record to ascertain if there is any other basis for the summary judgment which was entered.

The ultimate determination of consumer confusion is a question of fact. Albert Dickinson Co. v. Mellos Peanut Co. of Illinois, 7 Cir., 179 F.2d 265, 269; Coca-Cola Co. v. Snow Crest Beverages, Inc., 1 Cir., 162 F.2d 280, 283; Skinner Mfg. Co. v. Kellogg Sales Co., 8 Cir., 143 F.2d 895, 899; William R. Warner & Co. v. Eli Lilly & Co., 265 U.S. 526, 529, 44 S.Ct. 615, 68 L.Ed. 1161. "The ultimate question is always whether or not the public is likely to be deceived; and this is a question of fact, depending on all the attendant circumstances." Federal Glass Co. v. Loshin, 2 Cir., 224 F.2d 100, 101. All doubts as to whether there is a fact issue must be resolved against the moving party. Griffeth v. Utah Power & Light Co., 9 Cir., 226 F.2d 661, 669; Toebelman v. Missouri-Kansas Pipe Line Co., 3 Cir., 130 F.2d 1016, 1018; Weisser v. Mursam Shoe Corporation, 2 Cir., 127 F.2d 344, 346, 145 A.L.R. 467.

Plaintiff's answers to interrogatories show only that prior to March 1, 1954, cases of actual confusion had not come to the attention of officials of plaintiff, but this was prior to the survey which plaintiff conducted in August and September of that year. Furthermore, in said answers, plaintiff insisted that the likelihood of confusion did exist.

At the oral argument some point was made of the fact that at the time this action was commenced it was necessary to obtain a doctor's prescription for the ultimate consumer to obtain either Dramamine or Bonamine. However, proof was made that prior to the time when judgment was entered permission had been granted by the Department of Health, Education and Welfare to sell Dramamine in over-the-counter sales without prescription. Some inti-

mation was made that Bonamine could now or soon would be available in the same manner. What the fact is may be of importance on the question of consumer confusion. However, the District Court made no findings on this point, and this is only another indication as to why the case at bar should be decided on the merits after a trial, and not disposed of by summary judgment.

The judgment of the District Court is reversed and the cause remanded.

IN THE UNITED STATES DISTRICT COURT
N. D. ILLINOIS, E. D.

No. 53 C 2407.

G. D. Searle & Co., a Corporation,
Plaintiff,

v.

Chas. Pfizer & Co., a Corporation,
Defendant.

Feb. 3, 1958.

Findings of Fact and Conclusions of Law.

KNOCH, *District Judge.*

The Court has reviewed the record and briefs of counsel, has considered the authorities cited, and upon a consideration of the whole case makes the following:

Findings of Fact

1. Plaintiff is a corporation of Illinois, with its principal place of business at Skokie, Illinois. Defendant is a corporation of Delaware, with its principal place of business at Brooklyn, New York.

2. The amount in controversy between the parties exceeds the sum of $3,000, exclusive of interest and costs.

3. This is an action for trademark infringement and unfair competition based upon the alleged violation of plaintiff's rights in the Dramamine trademark because of defendant's use of its Bonamine trademark. Both of these trademarks are applied to pharmaceutical products which may be described as antihistamines which are used as motion-sicken remedies.

4. In 1947, plaintiff developed a pharmaceutical product, the descriptive name of which is dimenhydrinate.

5. On March 3, 1949, dimenhydrinate was released for sale on prescription.

6. Since 1949, plaintiff has manufactured, distributed, and sold, and is now selling, dimenhydrinate as a remedy for the prevention and treatment of motion sickness.

7. Plaintiff has sold dimenhydrinate under the trademark Dramamine since the product was first released for sale.

8. On or about December 1, 1953, defendant's motion sickness remedy, parachloramine, was released for sale upon prescription under the name Bonamine.

9. The products in issue are both members of the large and well-known chemical class of organic amines. The record shows that numerous products which have been sold in drugstores for years contain the amine suffix. Some of these products are antihistamines and some of them are motion sickness remedies. Some antihistamines are useful as motion sickness remedies.

10. The words Bonamine and Dramamine are unlike. As plaintiff argued that the two words represented sounds which were acoustically similar and often confused, the Court devoted close attention to the two words as variously pronounced by counsel and witnesses throughout the proceedings. It is the finding of the Court that plaintiff's view is not supported by the evidence.

11. Plaintiff had knowledge of defendant's intention to adopt Bonamine as a trademark for an antihistamine months before defendant committed itself to this mark.

12. On or about November 10, 1954, plaintiff was authorized by the Food and Drug Administration to sell the product sold under the trademark Dramamine over the counter without prescription.

13. On or about November 29, 1955, defendant was authorized by the Food and Drug Administration to sell the product sold under the trademark Bonamine over the counter without prescription.

14. Although neither of the tablets is particularly distinctive in appearance, they do differ from each other in color and size. The packaging also differs. It is plaintiff's contention that a confusing similarity exists not in physical appearance or dress but between the spoken sound and the appearance in print of the coined words constituting the two trademarks.

15. Physicians, pharmacists and users of medicine generally exercise a high degree of caution. Medicines for internal consumption to alleviate ills (as contrasted with confections or cleaners, for example) are purchased with great care.

16. The charge of trade disparagement is based upon an error in one of defendant's advertisements, which is attributable to an employee of an independent trade publication in which the advertisement appeared. The same advertisement, free from the error in question, appeared in numerous other trade publications at about the same time. There was no reference to plaintiff or its product in the erroneous advertisement, and the statement of which complaint is made, while not completely accurate, was within the bounds of permissible "puffing." Plaintiff was not damaged by this advertisement.

Conclusions of Law

1. The Court has jurisdiction of the parties and of the subject-matter of this action.

2. Defendant has not infringed plaintiff's Dramamine trademark or unfairly competed with plaintiff.

3. Plaintiff's charge of trade disparagement is without merit.

4. The complaint should be dismissed.

IN THE UNITED STATES COURT OF APPEALS
FOR THE SEVENTH CIRCUIT

No. 12321 SEPTEMBER TERM, 1958, JANUARY SESSION, 1959.

G. D. Searle & Co.,
Plaintiff-Appellant,

v.

Chas. Pfizer & Co., Inc.,
Defendant-Appellee.

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE NORTHERN DISTRICT OF ILLINOIS, EASTERN DIVISION.

March 26, 1959.

Opinion.

Before DUFFY, *Chief Judge* and HASTINGS and PARKINSON, *Circuit Judges.*

DUFFY, *Chief Judge.* This is an appeal from a judgment of the District Court dismissing plaintiff's action for infringement of a registered trademark and for unfair competition. The trademarks in this controversy are "Dramamine" used by plaintiff and "Bonamine" used by defendant. The trademarks are used for motion sickness remedies or preventives. These products are now sold to the general public without a physician's prescription.

In 1947 plaintiff developed a pharmaceutical product for use in the prevention and treatment of motion sickness. It adopted the coined and fanciful trademark "Dramamine." Tests were conducted in cooperation with the Surgeon General of the Army and doctors at Johns Hopkins Hospital which established the product's effectiveness both in the prevention and treatment of motion sickness. On February 14, 1949, the Surgeon General released a report of the results of these tests which received wide and favorable publicity. On March 3, 1949, Dramamine was released for sale by prescription. Prior to December 1, 1953, plaintiff's sales of Dramamine exceeded $12,000,000.00. About November 10, 1954, plaintiff was authorized to sell Dramamine over the counter without a prescription.

Plaintiff has sold its motion sickness remedy under the trademark "Dramamine" ever since it was placed on the market. It registered "Dramamine" as the trademark in the United States Patent Office on July 18, 1950, and the mark was given Registration No. 527862. The registration has become incontestable. 15 U.S.C. § 1065.

About July 1, 1953, defendant purchased the United States rights to a product known as U.C.B. 5062 which had been developed by a Belgian manufacturer and sold in Europe as a motion sickness remedy under the trademark "Postafene." Defendant requested certain of its employees to suggest a trademark for U.C.B. 5062, informing them the product was "to be indicated for use in motion-sickness and is competitive with Dramamine." One hundred fifty-eight names were suggested. From this long list defendant selected the name "Bonamine." Dr. Moore, a phonetics expert, testified that Bonamine was more like Dramamine than any other word on the list.

A somewhat similar situation existed in *Q-Tips, Inc. v. Johnson & Johnson*, 3 Cir., 206 F.2d 144, where the defendant was confronted with the trademark "Q-Tips." The court said, page 147: "The evidence shows a list of dozens of names suggested by various employees, many of

which are arbitrary, fanciful and completely unlike anything suggested by the plaintiff's product. But in the end defendant's top management came up with the name under discussion, 'Cotton Tips'. It is quite clear why, with all the possibilities open to it, defendant made this choice. • • •"

Defendant, a late-comer in the field, knew of plaintiff's use of the trademark Dramamine, and of the predominant position of Dramamine in the market at the time it chose to compete with its product which it designated as Bonamine. Defendant recognized this predominant position the following year when it issued instructions to salesmen stating "Dramamine has been on the market for a number of years and has been intensely promoted; consequently its biggest advantage now is that physicians have the Dramamine habit."

The statement which we made a number of years ago in *Northan Warren Corp. v. Universal Cosmetic Co.*, 7 Cir., (1927), 18 F.2d 774, 775, is a good and safe rule to follow: "One entering a field of endeavor already occupied by another should, in the selection of a tradename or trade-mark, keep far enough away to avoid all possible confusion. • • •"

Many products competitive to Dramamine came upon the market. On July 25, 1955, a district representative of Pfizer sent out a sales letter which contained the following: "The motion sickness market is a tremendous market running into millions and millions of dollars. At the present time, the bulk of this market is enjoyed by one of our competitors • • • your competition is Dramamine. • • •"

The trademark Dramamine is non-descriptive. In *G. D. Searle & Co. v. Institutional Drug Distributors, Inc.*, 141 F. Supp. 838, 839, Chief Judge Yankwich referred to Dramamine as "• • • a strong, non-descriptive and valid mark, used to designate tablets of Dimenhydrinate • • •" The same judge in *G. D. Searle & Co. v. Institutional Drug Distributors, Inc.*, 151 F. Supp. 715, 717, again referring

to Dramamine said: "The mark is not descriptive. By all standards it is a strong mark. • • • Marks of this character, especially when exploited on a national basis, have been given the highest protection by the courts both before and since the enactment of the Lanham Act. 15 U.S.C.A. §§ 1051, 1127. • • •" We agree with Judge Yankwich's statements.

Finding of Fact 10 states, "The words Bonamine and Dramamine are unlike. As plaintiff argued that the two words represented sounds which were acoustically similar and often confused, the Court devoted close attention to the two words as variously pronounced by counsel and witnesses throughout the proceedings. It is the finding of the Court that plaintiff's view is not supported by the evidence." There was no other finding as to likelihood of confusion.

That part of the finding which states Dramamine and Bonamine are unlike is clearly erroneous. Dramamine and Bonamine contain the same number of syllables; they have the same stress pattern, with primary accent on the first syllable and secondary accent on the third; the last two syllables of Dramamine and Bonamine are identical. The initial sounds of Dramamine and Bonamine ("d" and "b") are both what are known as "voiced plosives" and are acoustically similar; the consonants "m" and "n" are nasal sounds and are acoustically similar. The only dissimilar sound in the two trademarks is the "r" in Dramamine. Slight differences in the sound of similar trademarks will not protect the infringer. *Lambert Pharmacal Co. v. Bolton Chemical Corp.*, 219 Fed. 325, 326.

Finding 10 seems to indicate that the trial court was of the view it was plaintiff's burden to prove that the words "Dramamine" and "Bonamine" were often confused. Such is not the correct test in determining whether a trademark has been infringed. When this case was here before, we said, 231 F.2d 316, 317: "• • • it is not necessary to show actual cases of confusion since the test under

the statute, 15 U.S.C.A. § 1114(1), is likelihood of confusion." We cited *Independent Nail & Packing Company, Inc. v. Stronghold Screw Products, Inc.*, 7 Cir., 205 F.2d 921, 925, and *Keller Products, Inc. v. Rubber Linings Corp.*, 7 Cir., 213 F.2d 382, 386.

Section 2 of the Trade-Mark Act of 1946, 15 U.S.C.A. § 1114(1), gives the holder of a trademark, such as plaintiff, a right of action against "Any person who shall, in commerce, (a) use, without the consent of the registrant, any * * * colorable imitation of any registered mark in connection with the sale, offering for sale, or advertising of any goods * * * on or in connection with which such use is likely to cause confusion or mistake or to deceive purchasers as to the source of origin of such goods * * *."

Section 45 of that Act (15 U.S.C.A. § 1127) defines "colorable imitation" to include "any mark which so resembles a registered mark as to be likely to cause confusion or mistake or to deceive purchasers." Thus, it is clear that the test is likelihood of confusion and not the quantity of actual confusion.

Although plaintiff proved several instances of actual confusion, such proof is not required. Defendant's reliance on *Rytex Co. v. Ryan*, 7 Cir., 126 F.2d 952 is misplaced. That case does not express the rule in this circuit. In *Barbasol v. Jacobs*, 160 F.2d 336, 340, we said "* * * we are convinced that our holding in the *Rytex* case pertinent to the instant question was an erroneous statement of law."

That part of Finding 10 which states the court devoted close attention to the pronunciation of the two names by counsel and witnesses was, in effect, a side by side comparison. This is likewise not a correct test. This Court has discussed the frailty of such tests in *Colburn v. Puritan Mills, Inc.*, 108 F.2d 377, 378, and *Albert Dickinson Co. v. Mellos Peanut Co. of Illinois*, 179 F.2d 265, 269. In these two cases we stated the rule recognized in this circuit, *viz.*, we must determine the purchasing public's

state of mind when confronted by somewhat similar trade-names *singly* presented.

Since it is the effect upon prospective purchasers that is important, the conditions under which they act must be considered. *Albert Dickinson Co. v. Mellos Peanut Co. of Illinois*, 179 F.2d 265, 270.

The trademarks "Dramamine" and "Bonamine" designate products which have identical uses; are sold to the public through the same channels of trade; are widely promoted by word-of-mouth advertising and often are purchased through oral or telephone requests. The two products are sold to the same class of customers. All sales are made without direct advertising to the ultimate consumer. On a dosage basis, the two products are priced competitively. Each product is produced by a well-known pharmaceutical manufacturer.

Defendant argues Bonamine is a white tablet while Dramamine is yellow and that the shape and size of the bottle containers are different. Such differences would not be helpful in distinguishing between the products, as they are usually sold. In any event, such differences would not be controlling, for it is the similarity of the sound of Dramamine and Bonamine, and the methods used for promotion and marketing, that make for confusion.

Defendant cites a number of cases where the trademarks involved had similar suffixes but dissimilar prefixes and where the marks were held to be not confusingly similar. Some of the cases cited are: *Pennzoil Co. v. Crown Central Petroleum Corp.*, 4 Cir., 140 F.2d 387, involving the marks "Pennzoil" and "Greenzoil" for motor oil; *Syncromatic Corp. v. Eureka Williams Corp.*, 7 Cir., 174 F.2d 649, involving the marks "Syncromatic" and "Oil-O-Matic" for oil burning heaters; *Kensington Steel Co. v. Nichols Engineering and Research Corp.* (C.C.P.A.), 188 F.2d 397, involving the marks "Nercalloy" and "Oroloy" for metal castings; and *Upjohn Co. v. Schwartz*, 2 Cir., 246 F.2d 254, involving the marks "Syrocol" and "Cheracol."

A long list of cases could be cited where trademarks with dissimilar prefixes but with similar suffixes had been held to be confusingly similar. Typical are: "Q-Tips" and "Cotton Tips", *Q-Tips, Inc. v. Johnson & Johnson*, 3 Cir., 206 F.2d 144; "LaTouraine" and "Lorraine", *La-Touraine Coffee Co. Inc. v. Lorraine Coffee Co. Inc.*, 2 Cir., 157 F.2d 115; "Peroxogen" and "Dioxogen", *Bookman v. Oakland Chemical Co.* (C.C.P.A.) 40 F.2d 1006; "Anacin" and "Alycin", *William S. Merrell Co. v. Anacin Co.* (C.C.P.A.) 109 F.2d 339; "Miracle Whip" and "Salad Whip", *Kraft Cheese Co. v. Leston Co.*, 43 F.Supp. 782; "Cytamin" and "Dent-A-Min", *McKesson & Robbins, Inc. v. American Foundation for Dental Science*, (C.C.P.A.) 150 F.2d 420. In a case involving Simoniz and Permanize, the court pointed out that the only material difference was in the first syllable of each word, and the court stated: "* * * this court has repeatedly held that the public ought not to be required to dissect and analyze trademarks in order that confusion and deception might be avoided." *Simoniz Co. v. Permanizing Stations of America, Inc.*, (C.C.P.A.), 49 F.2d 846, 847.

In this type of litigation reference to decisions of courts as to other trademarks is not of great help. Citation of individual cases can only indicate a general pattern. Often the background of the adoption of the mark is of importance on the question of intent. The evidence as to actual confusion or likelihood of confusion differs widely from case to case. However, courts are alert to protect the purchasing public from the conduct of business concerns which do not hesitate to trade upon the good name and the success of a competitor. We think the evidence in this case compels a holding that the trademark "Bonamine" is likely to cause confusion and mistake among purchasers of drugs who seek relief from motion sickness. Defendant adopted the name "Bonamine" apparently with the idea of getting as close to "Dramamine" as was legally possible, but we hold the evidence in this case discloses that defendant got too close.

Defendant claims that plaintiff had knowledge of defendant's announcement of its intention to use the Bonamine trademark in August, 1953, but made no objection until after defendant had spent considerable sums in popularizing its product. In effect, defendant urges laches. The trial court made no finding on this point.

Defendant did announce its intention to use the trademark Bonamine by publication of the fact in what is known as The Combined Trade-Mark Bureau. A manufacturer may register a trademark with the Bureau which then publishes it in a bulletin circulated to the trade. The Bureau does not approve trademarks.

Although defendant listed Bonamine with the Bureau, it described Bonamine merely as an antihistamine. At that time defendant had determined that the therapeutic use of Bonamine was to be as a motion sickness remedy. In a broad sense, Bonamine, was an antihistamine, but defendant has never promoted and never planned to promote Bonamine as a general purpose antihistamine.

In November, 1953, plaintiff learned that defendant was using Bonamine as a motion sickness remedy. Plaintiff promptly protested and then started this action on December 16, 1953. Under the circumstances of this case there was no estoppel by laches.

We hold that plaintiff is entitled to an injunction restraining defendant from using Bonamine as a trademark for a motion sickness remedy. However, we do not think that there should be a reference for an accounting or an award of damages.

In this case there was proof of but two instances of "palming off", *and these were by dealers.* It was inherently impossible to prove more than a few instances of actual confusion. A purchaser who has been confused as to a product such as a drug tablet usually makes no complaint that can be traced or, in some instances as shown by the evidence in the instant case, does not learn of the mistake until many months later.

Defendant will suffer a substantial loss by the injunction restraining the use of Bonamine as a trademark. This litigation has now been in the courts over five years. A further controversy on the question of damages may well prolong this litigation for another five years. No one but the lawyers could benefit by such a course. Balancing the equities, we think justice will be served by restraining defendant prospectively from the use of the trademark Bonamine as a motion sickness remedy. See *Q-Tips, Inc. v. Johnson & Johnson*, 3 Cir., 206 F.2d 144, 148; *Champion Spark Plug Co. v. Sanders*, 331 U.S. 125, 131.

Judgment reversed with instructions to issue an injunction restraining prospectively the defendant from using the trademark Bonamine to indicate a product useful for or to be used as a motion sickness remedy or preventive.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1959.

No. 142

CHAS. PFIZER & CO., INC.,
Petitioner,

vs.

G. D. SEARLE & CO.,
Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

BRIEF FOR RESPONDENT IN OPPOSITION.

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THE GUNTHORP-WARREN PRINTING COMPANY, CHICAGO

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IN THE

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OCTOBER TERM, 1959.

No. 142.

CHAS. PFIZER & CO., INC.,

Petitioner,

vs.

G. D. SEARLE & CO.,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

BRIEF FOR RESPONDENT IN OPPOSITION.

STATEMENT OF THE CASE.

This is an ordinary trademark case. Its only unusual feature is the overwhelming quantity of uncontroverted evidence of infringement.

The facts of this case are simple:

In 1947, respondent, G. D. Searle & Co., developed a pharmaceutical product for which it adopted the descriptive name dimenhydrinate and the fanciful and coined trademark DRAMAMINE (J.A. 1278; App. B to Petition for Certiorari, 13a). After clinical testing by doctors at Johns Hopkins and the Surgeon General of the Army

which established its effectiveness, DRAMAMINE was released for prescription sale as a motion sickness remedy on March 3, 1949 (J.A. 33-34, 55-56, 901, 981-982, 1278; App. B, 13a).

DRAMAMINE was widely recognized as the first effective motion sickness remedy (J.A. 38, 911-917, 923-927). Prior to December 1, 1953, its sales had exceeded $12,000,000 (App. B, 13a). On November 10, 1954, DRAMAMINE was released for sale to the general public without prescription (J.A. 1040-1046, 1279; App. B, 13a).

Respondent's motion sickness remedy has been sold under the trademark DRAMAMINE since it was placed on the market (J.A. 1278; App. B, 13a). The trademark DRAMAMINE was registered in the United States Patent Office, and the registration has become incontestable (J.A. 979, 1255-58; App. B, 13a).

On or about July 1, 1953, petitioner, Chas. Pfizer & Co., purchased the United States rights to a product, U. C. B. 5062, which had been developed by a Belgian manufacturer and sold in Europe as a motion sickness remedy under the trademark "Postafene" (J.A. 118-119, 126-127, 1193-1194; App. B, 13a).

On or about June 29, 1953, petitioner requested certain of its employees to suggest a trademark for U. C. B. 5062, informing them that the product was "to be indicated for use in motion sickness and is competitive with Dramamine" (J.A. 983-985, 1057-1058; App. B, 13a). The name BONAMINE was selected from 158 names suggested by employees (J.A. 993-994, 996-997, 1001-1002).

In August, 1953, petitioner published the name BONAMINE in the Bulletin of the Combined Trademark Bureau of the American Drug Manufacturers Association and the American Pharmaceutical Manufacturers Association as a proposed trademark for an antihistamine, and *not* as a motion

sickness remedy, although the rules governing such publication required a statement of the *therapeutic* use of the product to which the name was to be applied (J.A. 1003, 1240; App. B, 19a).

Petitioner's product was released for prescription sale as a motion sickness remedy under the name BONAMINE on or about December 1, 1953 (J.A. 1278). Not until then did respondent discover that petitioner intended to use BONAMINE as a motion sickness remedy rather than an antihistamine (J.A. 74-77; App. B, 19a). Respondent promptly protested this use of the name BONAMINE, and on December 16, 1953, instituted this action for trademark infringement and unfair competition (J.A. 1, 1058-1059; App. B, 19a).

On November 29, 1955, BONAMINE was released for sale to the public without prescription (J.A. 1279).

The trial in this case occupied four and one-half days in May and June, 1957. At the trial, the uncontroverted evidence demonstrated that the products designated as DRAMAMINE and BONAMINE are sold for identical uses, are sold through the same channels of trade, are sold to the same class of customers, are sold without consumer advertising, are promoted by word-of-mouth advertising, are often purchased by oral or telephone requests, and are priced competitively (App. B, 17a*).

Respondent presented extensive testimony from members of the public establishing that the trademarks DRAMAMINE and BONAMINE are confusingly similar both in sound and appearance (J.A. 256, 265, 272, 282, 291, 297, 310, 321, 635, 1097-1192). Respondent presented evidence that petitioner's use of the name BONAMINE had resulted in actual confusion of the public between DRAMAMINE and BONAMINE

* J.A. 38, 101-102, 461, 1277-78; 27-30, 32, 38, 45-46, 210, 238-239, 394-397, 438, 458-459, 472; 30-32, 45-46, 438-439; 211-212, 239-240, 547-548, 1049, 1052-1057; 256-257, 265-266, 282-283, 291-292, 298-299, 310-311, 369-370; 247-248, 370; 1274.

as to the source of the goods sold under these trademarks (J.A. 40-43, 371-373, 399-403, 1065, 1144-1145; App. B, 16a). Respondent presented evidence that the similarity between the names DRAMAMINE and BONAMINE had resulted in the palming off of petitioner's product for that of the respondent (J.A. 343-344, 381-388; App. B, 19a).

Petitioner's only answer to this evidence was to attempt to attack the method employed by respondent in identifying some of the witnesses whose testimony was offered, and to criticize respondent for not calling to the stand every person ever interviewed as a prospective witness.

Respondent also presented the testimony of an expert witness who testified to the phonetic similarities between DRAMAMINE and BONAMINE. He made a phonetic comparison of the other 157 names considered by petitioner, finding BONAMINE the most similar to DRAMAMINE (J.A. 149, *et seq.*). Petitioner, of course, countered with its own expert who found only 17 other words on the list of 158 (including such words as "Transidene" and "Travelazine") to be more similar to DRAMAMINE than is BONAMINE (J.A. 489-581, particularly at 496-497). The two experts agreed that there were five points of similarity between the sounds DRAMAMINE and BONAMINE, however the words were pronounced:

1. DRAMAMINE and BONAMINE contain the same number of syllables.

2. DRAMAMINE and BONAMINE have the same stress pattern—primary accent on the first syllable and secondary accent on the third.

3. The last two syllables of DRAMAMINE and BONAMINE are identical.

4. The initial sounds of DRAMAMINE and BONAMINE ("d" and "b") are both what are known as "voiced plosives" and are acoustically similar.

5. The consonants "m" and "n" are nasal sounds which are acoustically similar (J.A. 156-158; 493, 515, 521; App. B, 15a).

The petitioner's expert witness further admitted that if the initial vowel sound in DRAMAMINE were pronounced "ah," DRAMAMINE and BONAMINE were rhyming words, and hence "confusable" words (J.A. 156-158; 515, 520). Although the experts disagreed as to whether or not the majority of the public would be more likely to pronounce the firsf syllable of DRAMAMINE with a broad or a short "a," other evidence clearly established that a substantial number of people actually pronounce it each way (J.A. 248, 370-371).

Respondent offered further evidence which clearly established that petitioner acquired the rights to the product it sold as BONAMINE for the purpose of entering the extensive market for motion sickness remedies which had been established by DRAMAMINE; that the dominant consideration in the selection of the name BONAMINE was the fact that the product was to be sold in competition with DRAMAMINE; that petitioner gave notice of its intention to use the name BONAMINE in a manner calculated to conceal its intention to use it for a motion sickness remedy; and that petitioner admittedly had no policy of seeking to adopt distinctive trademarks.*

Petitioner's principal defense rested in an attempt to persuade the courts to ignore the trademarks in suit, DRAMAMINE and BONAMINE, in their entireties, and to consider only their separate parts. It argued that the trial court should ignore the identical suffix "amine" and compare only the prefixes "dram" and "bon". It alleged that "amine" was descriptive of the products. This precise defense had previously been stricken in a Patent Office

* J.A. 100, 532, 1023; 38, 58, 63-64, 246; 1025; 984-985; 1003, 130, 460-463; 222.

proceeding instituted by respondent to prevent registration of BONAMINE. *G. D. Searle & Co.* v. *Chas. Pfizer & Co., Inc.*, 105 U. S. P. Q. 391 (1955).

Eight months after the trial ended, the District Court entered the findings and conclusions set forth at pages 9a through 11a of Appendix B to the petition. Respondent promptly appealed, on the ground that the findings of fact were inadequate to support the conclusion that petitioner had not infringed respondent's trademark in that

(1) the only finding relative to the trial court's conclusion (Finding No. 10) was conclusory and unsupported by the subsidiary findings,

(2) the finding was based on an erroneous theory of law, and

(3) the trial court had failed to make any findings with respect to the material issues of likelihood of confusion, actual confusion and palming-off, and intent.

Respondent further urged the Court of Appeals to enter judgment on the basis of the record below in view of the length of time the case had been pending and the fact that the evidence introduced was preponderantly documentary or by deposition, and consisted in large part of answers to interrogatories or admissions of fact.

As shown by its opinion, the Court of Appeals agreed that Finding 10 was the only finding relating to the issues in the case, and that the finding was, in part, based on an erroneous theory of law (App. B, 15a). It did not pass upon respondent's contention that the part of the trial court's finding which stated simply the trial court's conclusion that "The words 'DRAMAMINE and BONAMINE' are unlike" was conclusory. Instead, the Court of Appeals held the finding to be clearly erroneous. In reaching this conclusion, the Court relied only upon the undisputed evidence of record (App. B, 15a; pp. 4-5, *supra*).

Petitioner urged in the Court of Appeals, and urges now, that the trial court's ninth, fourteenth and fifteenth findings supported Finding 10 and the trial court's conclusion (Pet., pp. 2, 6-8).

The ninth finding (App. B, 10a) consisted of four sentences, all more or less true, but all meaningless in this case:

1. "The products [sold as DRAMAMINE and BONAMINE] are both members of the large and well-known chemical class of organic amines."

Even ignoring the fact that the product sold as DRAMAMINE is not itself an organic amine (J.A. 848), the only evidence of record indicated that the terms "amine" and "organic amine" had no meaning to the public (J.A. 258, 282, 284, 530-531; and see *American Home Products Corp.* v. *Willard*, 114 U. S. P. Q. 353, 354 (1957).

2. "The record shows that numerous products which have been sold in drugstores for years contain the amine suffix."

The record did disclose that some 66 products, ranging from antihistamines through vitamins, headache remedies, products for treating obesity, diuretics and urinary antiseptics, and even a deodorant, had been sold under names ending in "amine" (J.A. 666-669). If anything, this evidence demonstrated that only the rashest purchaser would rely on the suffix "amine" as describing the "chemical and physiological properties" of a product to which it was applied.

3. "Some of these [66] products are antihistamines and some of them are motion sickness remedies."

Ten of the 66 were antihistamines, and three, which were *not* antihistamines, were recommended for motion sickness (compare J.A. 1067-1096 with J.A. 666-669). In fact, of the forty-three motion sickness remedies and the

110 antihistamines on the market in 1954, only five motion sickness remedies and six antihistamines had names ending in either "amine" or "amin" (J.A. 1075, 1085).

4. "Some antihistamines are useful as motion sickness remedies."

But as petitioner's exhibits demonstrated, most antihistamines are not, and "no correlation appears to exist between antihistamine potency and motion sickness protection" (J.A. 784-785, 838). Furthermore, only six products are recommended both as antihistamines and as motion sickness remedies (J.A. 1075, 1085). Neither DRAMAMINE nor BONAMINE has ever been recommended as an antihistamine although both, technically, fall in that category (J.A. 1271-1272; 128-129, 460-463, 983-985).

The half-truths of Finding No. 9, viewed against the record, do not support petitioner's contention that the suffix "amine" is either "a well-known technical term" or that it is descriptive of the "chemical and physiological nature" of the products sold as DRAMAMINE and BONAMINE, or that it is commonly employed for motion sickness remedies (Pet., p. 6).

In any event, even if petitioner's contention were well-founded, they would be relevant only if its claims that the court should consider the trademarks bit by bit rather than as a whole and that common elements of trademarks can be disregarded in determining likelihood of confusion were legally valid. If there is one aspect of trademark law which is established beyond question, it is that likelihood of confusion must be determined by comparing the similarities between the trademarks in their entirety, and can never be disproven by disregarding common elements. *Younghusband* v. *Kurlash Co.*, 94 F. 2d 230, 231 (C. C. P. A., 1938); *Miles Laboratories, Inc.* v. *Pepsodent Co.*, 104 F. 2d 205, 207 (C. C. P. A., 1939); *Syncromatic Corp.* v. *Eureka Williams Corp.*, 174 F. 2d 649, 650

(C. A. 7, 1949); *Nestle's Milk Products, Inc.* v. *Baker Importing Co.*, 182 F. 2d 193, 196 (C. C. P. A., 1950); *Schering & Glatz, Inc.* v. *Sharp & Dohme, Inc.*, 146 F. 2d 1019, 1021 (C. C. P. A., 1944); *The Quaker Oats Co.* v. *St. Joe Processing Co.*, 232 F. 2d 653, 656 (C. C. P. A., 1956); *Perfectform Corp.* v. *Perfect Brassiere Co.*, 256 F. 2d 736 (C. A. 3, 1958); *Dietene Company* v. *Dietrim Company*, 225 F. 2d 239, 243 (C. A. 8, 1955); *N. K. Fairbanks Co.* v. *Ogden Packing & Provision Co.*, 220 Fed. 1002, 1003 (D. Utah, 1914).

The fourteenth finding states merely:

> "Although neither of the tablets is particularly distinctive in appearance, they do differ in color and size. The packaging also differs. It is plaintiff's [respondent's] contention that a confusing similarity exists not in physical appearance or dress but between the spoken sound and the appearance in print of the coined words constituting the two trademarks" (App. B, 11a).

If this finding was intended as anything more than a restatement of respondent's claim, the evidence relating to the manner of marketing and promoting these products reviewed above clearly demonstrated that differences in the appearance and packaging of the products is of little or no assistance to the public in distinguishing between them (see p. 3, *supra*; App. B, 17a).

The fifteenth finding, that "users of medicine generally exercise a high degree of care" and that "medicines * * * are purchased with great care," is wholly unsupported by any evidence and offends common sense.

The only "evidence" on this subject consisted of the statement of the sales manager of respondent that he was not qualified to testify whether or not the consumers purchasing motion sickness remedies were "intelligent and discriminating" (J.A. 356-358), and the statement of an

officer of petitioner that the "adult portions of the American population certainly are discriminating and intelligent" (J.A. 443-444).

While users of some medicines are, of course, cautious, there is no evidence that purchasers of motion sickness remedies sold over the counter would exercise "great care" to get DRAMAMINE rather than BONAMINE, or vice versa. Both are used and are effective for identically the same purpose, and both are produced by well-known pharmaceutical manufacturers and sold to the general public without prescription.

The Court of Appeals having found the only material finding made by the trial court to be clearly erroneous did review the record below and concluded that "the evidence in this case compels a holding that the trademark "Bonamine" is likely to cause confusion and mistake among purchasers of drugs who seek relief from motion sickness" (App. B, 18a). It directed the District Court to enter an injunction restraining the use of the trademark BONAMINE for motion sickness remedies.

ARGUMENT.

I. THE "QUESTIONS PRESENTED" STATED BY PETITIONER ARE NOT PRESENTED IN THIS CASE.

Whatever interest this Court might have in the questions stated by the petitioner (Pet., p. 4), those questions are not presented by this case.

As shown by the foregoing statement of the case, the three questions stated by petitioner should be restated as follows:

1. In a case where one trademark is alleged to be confusingly similar to another because of their acoustic similarity, is an appellate court justified in setting aside, as clearly erroneous, a bare finding that the trademarks are "unlike" where the undisputed evidence establishes at least five material points of similarity between the sounds of the two trademarks, however pronounced?

2. In determining whether or not the concurrent use of two trademarks in the sale of substantially identical products is likely to result in confusion, may a trial judge rely solely upon his personal impression of the acoustic similarity of the trademarks as pronounced by counsel and witnesses in the courtroom, and wholly ignore undisputed evidence that

   a. as established by petitioner's and respondent's experts, the trademarks have at least five material points of acoustic similarity;

   b. the products were marketed and promoted through the same channels of trade and by the same media;

   c. the concurrent use of the two trademarks had resulted in actual confusion;

d. the concurrent use of the two trademarks had resulted in the palming-off of petitioner's product for that of respondent; and

e. petitioner had deliberately adopted its trademark with the intent of trading upon the goodwill attaching to respondent's trademark?

3. Where, in a trademark case, the appellate court determines that the only finding made by the trial court as to likelihood of confusion is, in part, clearly erroneous, and, as to the balance, based upon an erroneous theory of law, must the appellate court remand the case to the trial court, where the evidence of record is composed in large part of documents, depositions, answers to interrogatories or admissions, the relevant oral testimony is undisputed, and the record as a whole "compels" the conclusion that one party is entitled to judgment?

The answers to these questions are clear, and present no occasion for review by this Court.

II. THERE IS NO CONFLICT BETWEEN THE INSTANT DECISION AND ANY DECISION OF THIS OR ANY OTHER COURT INTERPRETING RULE 52(a).

The cases relied upon by petitioner [*Graver* v. *Linde*, 336 U. S. 271; *Benrose Fabrics Corp.* v. *Rosenstein*, 183 F. 2d 355 (C. A. 7, 1950); *S. C. Johnson & Son, Inc.* v. *Johnson*, 121 U. S. P. Q. 63 (C. A. 6, 1959)] merely establish the undisputed rule that an appellate court may not set aside a finding of the trial court unless the finding is clearly erroneous. Rule 52(a), F. R. C. P.

In the present case, the Court of Appeals adhered to that rule. It set aside only one finding of the trial court; it fould that finding to be clearly erroneous since it conflicted squarely with the undisputed evidence of record (App. B, 15a). There was no substantial evidence to support the finding.

There is no legal issue to be resolved, and no conflict of decision.

III. THERE IS NO CONFLICT BETWEEN THE INSTANT DECISION AND OTHER TRADEMARK DECISIONS.

Likelihood of confusion is a question of fact. *G. D. Searle & Co.* v. *Chas. Pfizer & Co.*, 231 F. 2d 316 (C. A. 7, 1956) (App. B, 7a). The fact that one court determines that two trademarks are not confusingly similar and another court finds that two entirely different trademarks are confusingly similar, does not mean the decisions are in conflict.

As the Court of Appeals sensibly stated in this case:

> "In this type of litigation reference to decisions of courts as to other trademarks is not of great help. Citation of individual cases can only indicate a general pattern. Often the background of the adoption of the mark is of importance on the question of intent. The evidence as to actual confusion or likelihood of confusion differs widely from case to case." (App. B, 18a.)

Nor does the fact that courts find some trademarks confusingly similar and others not confusingly similar evidence any uncertainty in the lower courts concerning the resolution of questions of likelihood of confusion. The lower courts have no difficulty resolving each case on its own facts.

IV. THIS PETITION PRESENTS NO QUESTIONS OF PUBLIC IMPORTANCE RELATING TO THE CONSTRUCTION OF THE TRADEMARK ACT OF 1946.

Petitioner asserts that the Trademark Act of 1946 fails to establish standards for determining when a mark is likely to cause confusion and mistake. These standards were well established when the Act was adopted.

The clearest of these standards is simply stated:

> The test of likelihood of confusion is whether or not the public is likely to be confused by the trademarks singly presented, and not whether the court can, upon comparison, distinguish between them. *Albert Dickinson Co. v. Milos Peanut Co. of Illinois*, 179 F. 2d 265, 270 (C. A. 7, 1950); *Colburn v. Puritan Mills, Inc.*, 108 F. 2d 377, 378 (C. A. 7, 1939).

In the present case, the trial court based its decision that the trademarks in suit were not acoustically similar on its "close attention" to the pronunciation given to the words by counsel and witnesses, and not on the evidence (J.A. 1278, App. B, 10a). In effect, the trial court said, "I've listened carefully to these two words, pronounced one after the other by the lawyers and the witnesses, and they didn't sound alike to me personally." As the Court of Appeals held, this type of comparison is no different from the side-by-side visual comparison condemned by the courts (App. B, 16a-17a).

The application of this conventional test in this case certainly creates no uncertainty as to the interpretation of the Trademark Act and requires no action by this Court.

V. THE COURT OF APPEALS ACTED PROPERLY IN DIRECTING THE ENTRY OF JUDGMENT FOR THE RESPONDENT.

Petitioner has confused what respondent asked the Court of Appeals to do with what the Court actually did. Petitioner characterizes the Court of Appeals' decision as a determination that the findings made were inadequate. What the Court of Appeals actually held was that the only relevant finding was clearly erroneous. It expressed no opinion as to its adequacy if it had been supported by any substantial evidence.

Of course, whether the trial court's findings are viewed as clearly erroneous or as inadequate, the reviewing court is not required to remand the case for further findings if it can determine from the record before it that one party or the other is clearly entitled to judgment. *Kweskin* v. *Finkelstein*, 223 F. 2d 677, 679 (C. A. 7, 1951); 28 U. S. C. § 2106.

In this case, the bulk of the record consisted of admissions of fact, answers to interrogatories, depositions, and documents. The oral evidence was largely undisputed; the only possible conflict was between opinions of expert witnesses, who actually agreed on the material points of fact. The Court of Appeals was not required to set aside any findings of the trial court except the single finding which was clearly erroneous.

The Court of Appeals found that the record before it *compelled* a holding in favor of respondent (App. B, 18a). A review of the court's opinion confirms this conclusion.

It is no wonder that petitioner seeks a new trial. (Respondent cannot conceive that petitioner seriously contends that the trial court's judgment should be reinstated.) Petitioner, by virtue of an erroneous summary judgment, an untenable trial court decision, and the filing of this petition, has been enabled to enjoy the fruits of its deliberate infringement of respondent's trademark for almost six years. A new trial will permit it to continue to trade upon respondent's goodwill for a further period. Since the Court of Appeals restricted respondent to injunctive relief, respondent will never be made whole.

A new trial would be a futile gesture in this case. Petitioner had four years to get ready for the first trial, and failed to present any substantial evidence. On any record like that now before the Court, the conclusion reached by the Court of Appeals is the only conclusion possible.

CONCLUSION.

This litigation is of importance only to the litigants; it is not of such gravity and general importance as to justify a review by this Court.

The petition for a writ of certiorari should be denied.

Respectfully submitted,

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CERTIFICATE OF SERVICE.

I, Stuart S. Ball, one of the attorneys for G. D. Searle & Co., respondent herein, and a member of the Bar of the Supreme Court of the United States, hereby certify that on the 21st day of August, 1959, I served the foregoing brief in opposition on the petitioner by mailing copies in duly addressed envelope, with first class postage prepaid, to its attorney of record.

.....

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JAMES R. BROWNING, Clerk

IN THE

Supreme Court of the United States

October Term, 1959.

No. 142.

CHAS. PFIZER & CO., INC.,

Petitioner,

v.

G. D. SEARLE & CO.,

Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Seventh Circuit.

PETITIONER'S REPLY BRIEF.

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IN THE

Supreme Court of the United States.

OCTOBER TERM, 1959.

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CHAS. PFIZER & CO., INC.,

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v.

G. D. SEARLE & CO.,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

PETITIONER'S REPLY BRIEF.

Respondent's brief largely ignores the essential facts of record in this case which led the trial judge to find as a fact that the trademarks in issue "are unlike". This finding completely disposed of the ultimate factual issue involved in the case—whether the products of the parties are likely to be confused because petitioner's trademark is a colorable imitation of respondent's. The subsidiary finding that the trademarks are not "acoustically similar" disposed of the specific contention upon which respondent had relied in the trial court.

These findings were swept aside by the court of appeals; the first because it was categorized as "clearly

erroneous", and the second because the court of appeals ruled the trial judge could not determine acoustic dissimilarity from the testimony adduced during the trial. After thus disposing of these findings, the court of appeals then proceeded to arrive at contrary findings from the same record.

The pertinent findings of the trial judge and the evidence which supports them are set forth in our petition (pp. 6-10). Whether, as respondent attempts to show, there was some evidence to support the findings of fact by the court of appeals, reversing those of the trial judge, is immaterial.

The basic questions raised by the record in this case, as pointed out in our petition (p. 4) are:

1. Was the finding by the trial judge that the trademarks in issue are "unlike" one another clearly erroneous?

Both the court of appeals and respondent have ignored the substantial oral and documentary evidence which supports this finding, thereby permitting themselves to do violence to F. R. C. P. 52(a), as construed by this Court in *Linde v. Graver*, 336 U. S. 271, and by the courts of appeal of other circuits in more recent decisions (petition, pp. 11-13).

2. Is the ruling of the court of appeals correct, that the trial judge, in determining whether two trademarks are acoustically similar, cannot observe the manner in which they are pronounced by counsel and witnesses throughout the trial?

The test of acoustic similarity is dispositive of many trademark infringement and unfair competition cases, but the amazing decision of the court of appeals required the trial judge to close his ears to the best evidence upon which this issue can be adjudicated (petition, pp. 15-16).

3. If the findings of fact by the trial judge are held to be insufficient by the court of appeals, may it then resolve sharp conflicts in the evidence and make its own findings of fact, or should it remand the case to the district court for supplemental findings or a new trial?

Only the trial judge has the opportunity to observe the demeanor of the witnesses and to judge of their credibility, so conflicts in their testimony on basic issues should be disposed of by him rather than the appellate court (petition, pp. 14-15).

In addition to ignoring the essential facts of record on which the trial judge's findings are based, and referring to conflicting evidence as "undisputed", respondent's brief places great stress upon an unfairly slanted version of its so-called evidence of confusion.

Respondent's brief refers (p. 3) to what it calls "extensive testimony from members of the public establishing that the trademarks DRAMAMINE and BONAMINE are confusingly similar in both sound and appearance". A short discussion of this testimony is in order because it illuminates an insidious technique which permits a wealthy trademark owner to take unfair advantage of a defendant in this type of litigation.

Respondent produced its "evidence" as to the likelihood of consumer confusion by means of an elaborate special survey conducted by professional investigators working under close supervision of respondent's attorneys and paid by respondent. The survey extended over a period of more than two years and involved subjecting approximately 7,000 individuals throughout the country to "sidewalk interviews" (J. A. 423-5, 683-705). The investigators asked questions from forms of questionnaire which violated basic rules for conducting interviews by using the very names which the persons interviewed were supposed to volunteer without prompting (J. A. 492) and by employing

grossly leading questions to suggest there had been confusion between the names (J. A. 665). Eight different forms of questionnaire were used (J. A. 658-65) while respondent was, in the language of its chief investigator, "experimenting trying to find a questionnaire that would serve the purpose" (J. A. 691).

Despite the unfair manner in which the survey was conducted, virtually no one interviewed had any difficulty in distinguishing between the names BONAMINE and DRAMAMINE. Respondent took the depositions of about twenty persons who had been interviewed, whom respondent's chief investigator stated were his "best prospects" (J. A. 703-4). Of these, five turned out to be so unfavorable to respondent that respondent did not want them in evidence and they had to be offered by petitioner. The remainder showed either no confusion whatever or a borderline form of confusion which was attributable to the manner in which the survey was conducted rather than to any similarity between the names (J. A. 564-657, 1097-1192).

One of the "best prospects" was a Miss O'Connor, who testified she had never bought or used any motion sickness remedies, but that she had heard of DRAMAMINE. When asked whether she was familiar with BONAMINE she answered "No", thereby demonstrating her own lack of confusion in distinguishing between the two names (J. A. 576). Notwithstanding this, respondent's chief investigator, Mr. Christophersen, gave her two briefings in the period following her interview and before she gave her deposition, during which he "explained" to her why she nevertheless was confused (J. A. 581-3).

Two others of the "best prospects" were a Mr. Rauch and a Mr. Ackles, who each testified that the interviewers mispronounced the name BONAMINE as though it were spelled B-R-A-M-A-M-I-N-E or B-R-O-N-A-M-I-N-E (J. A. 505-6, 1123-4, 1127).

The witness on whom respondent relied primarily was a Mrs. Lort, who had been purchasing DRAMAMINE for six or

seven years. She testified that on one occasion she had sought to purchase DRAMAMINE for her children in a drug store but instead received BONAMINE (J. A. 383-7), but her testimony was contradicted in many material respects by her husband (J. A. 588-99). Since Mrs. Lort testified in person at the trial, her credibility could best be judged by the trial judge.

Other testimony of this character presented by respondent came from respondent's own officers who testified in person as to supposed instances related to them by friends and relatives or overheard at a busy airport (J. A. 39-43, 94-5, 344, 401-3). Being hearsay, this was entitled to little or no weight. None of these supposedly confused persons were produced.

Respondent's other main attack is to criticize petitioner (brief, pp. 2-3) for having published the name BONAMINE in the bulletin of the combined Trademark Bureau of the American Drug Manufacturers Association and American Pharmaceutical Manufacturers Association as a proposed trademark for an antihistamine, and not as a motion sickness remedy. This criticism is unjustifiable, not only because respondent admits (brief, p. 8) that antihistamines are frequently used for motion sickness and, as the district court found, both DRAMAMINE and BONAMINE are antihistamines (App. B. 10a, Finding No. 9), but also because when respondent itself published its name DRAMAMINE in the same publication it too described the product to which it was to be applied as an antihistamine and made no reference to its therapeutic usefulness as a motion sickness remedy (J. A. 893). Indeed, respondent *expressly* refused to state any therapeutic use (J. A. 892).

Before concluding, we call the Court's attention to the fact that a petition for a writ of certiorari (No. 147, October Term, 1959) has been filed in *S. C. Johnson & Son, Inc. v. Johnson*, 121 USPQ 53 (CA 6, March 30, 1959), one of the cases cited in our petition (pp. 12-13) as being in conflict with the decision of the court of appeals in the instant case.

We respectfully submit that respondent's brief in opposition actually demonstrates that this case is one of those which ought to be reviewed by this Court in the exercise of its discretionary jurisdiction. We believe no better opportunity can be found for resolving the important questions presented which have been most troublesome to the public and to the lower courts generally.

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